

MAR 12 2004

# OFFICIAL

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

**REPLY BRIEF UNDER 37 C.F.R. § 1.193**

20 Honorable Commissioner for Patents  
Alexandria, Virginia 22313

Sir:

25 Patentability of Claims Over Colonna & Courtecuisse

### Summary of Examiner's Answer

30 In the Examiner's Answer to Appellants Brief of 30 October 2003,  
the Examiner maintains the rejections of independent Claims 10-12 and 18-21  
under 35 USC 103(a) as being unpatentable over U.S. Patent No. 6,115,620  
(Colonna) in view of FR 2,679,086 (Courtecuisse).

In the Examiner's 'Response to Arguments', the Examiner  
35 incorrectly contends that the

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... device as taught by Colonna et al only functions in speakerphone mode when the user sets the second housing portion 204 (fig. 3) at a specific speakerphone position (col. 15, lines 6-8; col. 5, lines 41-45) *without* [emphasis supplied by Appellant] the need of activation of a button yet, it is still then set to speakerphone mode via a specific configuration of housing 204.

Discussion of Speakerphone Function of Colonna

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Contrary to the Examiner's assertion, the device of Colonna does not operate in speakerphone mode merely upon configuring the housing 204. Colonna states specifically (at col. 6, lines 30-34) that to switch operation to the speakerphone mode,

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... the user *must* place the second housing element to the speakerphone position and *then* toggle the activation element [emphasis supplied by Appellant].

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Colonna discusses the activation element at col. 4, lines 44-46 and col. 5, lines 26-31. Colonna teaches (at col. 15, lines 6-10) reducing the likelihood of acoustic shock by configuring the housing in a v-shaped configuration (in FIG. 3) to prevent location of the speakerphone too near users' ears when operating in speakerphone mode. Colonna does not teach switching the device to speakerphone mode by configuring the housing, as suggested by the Examiner and discussed further below.

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### Discussion of Patentability of Independent Claim 10

Regarding Independent Claim 10, because Colonna requires two acts (configuration of the housing 204 and subsequent actuation of the toggle switch) to configure the device in the speakerphone mode Colonna cannot be interpreted to read on Claim 10, which recites as follows:

10 [a] wireless communication handset, comprising:  
first and second rotatably coupled housing portions,  
the first and second housing portions rotatable in  
corresponding first and second substantially parallel planes;  
15 the wireless communication handset in a standby mode  
when the first and second housing portions are rotated to a  
standby angular configuration;  
the wireless communication handset in a call mode when  
the first and second housing portions are rotated from the standby  
angular configuration to a call angular configuration,  
20 the wireless communication handset performing a first  
function when the first and second housing portions are rotated to  
a first function angular configuration between the standby and  
call angular configurations

In Colonna, configuration of the housing 204 alone does not and cannot invoke the speakerphone function. Colonna categorically states that two conditions must be satisfied to invoke the speakerphone mode: 1.) configuration of the housing 204, and 2.) toggling of the activation element. Colonna, col. 6, lines 25 30-34, col. 5, lines 26-31. Thus Colonna does not disclose or suggest a communication handset that performs "... a first function when the first and second housing portions are rotated to a first function angular configuration

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..." as recited in Claim 10 while meeting the other limitations of Claim 10. Claim 10 is therefore patentably distinguished over Colonna.

Lack of Motivation to Combine or Modify Colonna in View of Courtecuisse

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The Appellants discussion of Colonna's express intention to prevent the likelihood of acoustic shock (at col. 15, lines 6-10) is presented to support Appellants' contention that there was no motivation to combine the rotatable blade of Courtecuisse with the flip phone of Colonna as asserted by the Examiner. Particularly, Colonna discloses configuring the clamshell housing in a partially open v-shaped configuration to prevent the user from placing the speaker too near the user's ear when in speakerphone mode. Colonna does not configure the housing to actuate speakerphone mode.

10 To replace the flip housing of Colonna with the rotatable blade of Courtecuisse, as suggested by the Examiner, would undermine the express intent of Colonna to configure the housing in a manner that prevent placing the speaker too near the ear. Only the v-shaped housing configuration (illustrated in FIG. 3) of Colonna satisfies prevents placement of the speakerphone too near the user's ear. The flat housing configuration of Courtecuisse would not prevent one from placing the speakerphone too near the ear. Thus the Examiner's proposed modification is contrary to the teachings of Colonna. For these and other reasons set forth previously, there would have been no reason or motivation for the combination of modification of Colonna asserted by the Examiner.

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Discussion of Examiner's Alternate Interpretations of Colonna

The Examiner's alternative interpretation of Colonna that the first position of the device of Colonna corresponds to the claimed "standby mode", and that the normal/private mode of Colonna corresponds to the claimed "first function" of first angular configuration also fails. The alternative interpretation of Colonna leaves uncovered the "call mode" limitation of Claim 10. The normal/private mode of Colonna cannot read on both the "first function" mode and the "call mode" of Claim 10.

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Discussion of Patentability of Independent Claim 18

Regarding independent Claim 18, because Colonna requires two acts (housing configuration and subsequent actuation of the toggle switch) to configure the device in the speakerphone mode Colonna cannot possibly be interpreted to read on a method in a communication handset having a blade rotatably coupled to a housing, comprising:

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[a] method in a communication handset having a blade rotatably coupled to a housing, comprising:

transitioning the communication handset from a stand-by operating mode to an active operating mode by rotating the blade in a plane relative to the housing from a standby mode position to an active mode position;

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invoking a first function of the communication handset by rotating the blade to a first position different than the active mode and standby mode positions;

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transitioning the communication handset to the stand-by mode by rotating the blade to the standby mode position from some other position.

5 In Colonna, configuration of the housing 204 alone does not and cannot invoke the speakerphone function. Colonna categorically discloses that two conditions must be satisfied to invoke the speakerphone mode: 1.) configuration of the housing 204, and 2.) toggling of the activation element. Colonna, col. 6, lines 30-34, col. 5, lines 26-31. Thus Colonna does not disclose or suggest a communication handset "... invoking a first function of the communication handset by rotating the blade to a first position different than the active mode and standby mode positions ..." as recited in Claim 18 while meeting the other limitations of Claim 18. Claim 18 is therefore patentably distinguished over Colonna.

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15 Lack of Motivation to Combine or Modify Colonna in View of Courtecuisse

20 The Appellants discussion of Colonna's express intention to prevent the likelihood of acoustic shock (at col. 15, lines 6-10) is presented to support Appellants' contention that there was no motivation to combine the rotatable blade of Courtecuisse with the flip phone of Colonna as asserted by the Examiner. Particularly, Colonna discloses configuring the clamshell housing in a partially open v-shaped configuration to prevent the user from placing the speaker too near the users ear when in speakerphone mode.

25 Colonna does not configure the housing to actuate speakerphone mode.

To replace the flip housing of Colonna with the rotatable blade of Courtecuisse, as suggested by the Examiner, would undermine the express

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intent of Colonna to configure the housing in a manner that prevent placing the speaker too near the ear. Only the v-shaped housing configuration (illustrated in FIG. 3) of Colonna satisfies prevents placement of the speakerphone too near the user's ear. The flat housing configuration of Courtecuisse would not prevent one from placing the speakerphone too near the ear. Thus the Examiner's proposed modification is contrary to the teachings of Colonna. For these and other reasons set forth previously, there would have been no reason or motivation for the combination of modification of Colonna asserted by the Examiner.

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#### Discussion of Examiner's Alternate Interpretations of Colonna

The Examiner's alternative interpretation of Colonna that the first position of the device of Colonna corresponds to the claimed "standby mode", and that the normal/private mode of Colonna corresponds to the claimed "first function" of first angular configuration also fails. The alternative interpretation of Colonna leaves uncovered the "active mode" limitation of Claim 18. The normal/private mode of Colonna cannot read on both the "first function" mode and the "active mode" of Claim 18.

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#### Discussion of Patentability of Claims 11 & 19

Claim 11, dependent from Claim 10, recites "...the wireless communication handset performing a second active mode function when the first and second housing portions are rotated to a second angular configuration between the standby and call angular configurations...."

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Claim 19, dependent from Claim 18, recites "... invoking a second function of the communication handset by rotating the blade to a second position."

Regarding Claim 11, the Examiner's contention that the private/normal mode of Colonna corresponds to the "...second function..." of Claim 11 does not stand to reason. Claim 10 requires a "call mode", "first function" mode and a "second function" mode. The private/normal mode of Colonna cannot correspond to both the "call mode" function and "second function" of Claim 10 as asserted by the Examiner. Courtecuisse does not 5 remedy the omissions of Colonna.

Regarding Claim 19, the Examiner's contention that the private/normal mode of Colonna corresponds to the "...second function..." of Claim 19 does not stand to reason. Claim 19 requires an "active mode", "first function" mode and a "second function" mode. The private/normal mode of Colonna cannot correspond to both the "active mode" function and "second function" of Claim 19 as asserted by the Examiner. Courtecuisse does not 10 remedy the omissions of Colonna.

Claims 11 and 19 are thus patentably distinguished over Colonna and Courtecuisse.

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### Discussion of Patentability of Claim 20

Regarding Claim 20, the Examiner's assertion that "... sensor 112 [of Colonna] may represent the physical sensation ..." of claim 12 is entirely 25 unsupported by Colonna.

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Claim 20 recites in combination with independent Claim 18, "... , indicating the position of the blade relative to the housing by providing a physical sensation when the blade is the respective positions."

5 The sensor 112 of Colonna merely detects physical orientation of the housing and sends a configuration signal to the controller. Colonna, col. 3, lines 23-32. There is absolutely no disclosure in Colonna that the sensor 112 of Colonna provide "... a physical sensation ...." Claim 20 is thus patentably distinguished over Colonna and Courtecuisse.

10 Discussion of Examiner's Answer Regarding Claim 21

Regarding Claim 21, Colonna and Courtesuisse does not disclose or suggest a

15 ... wireless communication handset, comprising:  
first and second rotatably coupled housing portions,  
the first and second housing portions rotatable in  
corresponding first and second substantially parallel planes;  
20 the wireless communications handset in a first operating  
mode when the first and second housing portions are rotated to a  
first angular configuration,  
the wireless communications handset in a second operating  
mode when the first and second housing portions are rotated to a  
second angular configuration,  
25 the wireless communications handset in a third operating  
mode when the first and second housing portions are rotated to a  
third angular configuration.

30 Contrary to the Examiner's assertion, Colonna does not disclose operating in three different modes when the first and second housing portions

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are rotated to corresponding first, second, and third configurations. In Colonna, configuration of the housing portions enables only two modes of operation: private mode and standby mode. The speakerphone (third) mode of operation in Colonna requires either that switch (230) be toggled or that EM sensor (116) sense a magnetic field, before operating in the speakerphone mode. Colonna, col. 4, lines 44-65, col. 6, line 30-34, col. 15, lines 6-14. In Colonna, mere positioning of the flip cover 204 to the position illustrated in FIG. 3 will not enable or invoke speakerphone mode.

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Colonna teaches configuration of the housing in a v-shaped configuration to prevent location of the speakerphone too near users' ears when operating in speakerphone mode. Colonna does not teach switching the device to speakerphone mode by configuring the housing as implied by the Examiner. Replacing the flip housing of Colonna with the rotatable blade of Courtecuisse, as suggested by the Examiner, would undermine the express intent of Colonna to configure the housing in a manner that prevent placing the speaker too near the ear. The flat housing configuration of Courtecuisse would not prevent one from placing the speakerphone too near the ear. For these and other reasons set forth previously, there would have been no reason or motivation for the combination of modification of Colonna asserted by the Examiner.

Claim 21 and the claims that depend therefrom are thus patentably distinguished over Colonna and Courtecuisse.

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Prayer for Relief

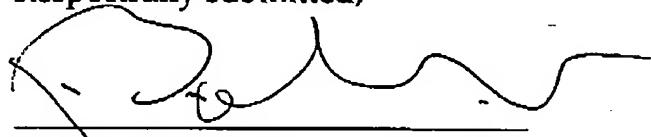
Kindly reverse the rejections of Claims in view of the discussion  
above, and remand the matter with instructions for the Examiner to allow said  
5 Claims to issue in a United States Patent without further delay.

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Respectfully submitted,



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